

REMARKS

Claims 1-7 are pending in this application.

The Examiner objected to the drawings because of a minor informality. Specifically, element 50, as shown in Figures 3 and 4, is not described in the specification. Applicants thank the Examiner for her suggestion, and have amended paragraph [0047] to show that element 50 refers to that portion of a subject's arm extending below the elbow to the wrist. No new matter has been added.

Applicants note the provisional rejections of claim 1 for nonstatutory obviousness-type double patenting over claims in copending U.S. Application No. 10/758,000. Due to the provisional nature of these rejections, applicants are not obliged to respond to the merits of the rejections at this time.

The Examiner rejected claim 1 under 35 USC 101 because the claimed invention was directed to non-statutory matter. Applicants have amended claim 1 to overcome this rejection and have also amended claim 1 to show that the sensing unit and pressure part control unit are separate units. As a result, any noise superimposed on the signal cable is reduced, and the pulse wave can be measured with greater accuracy. Support for this is found at paragraph [0064]. Applicants have also made minor amendments to claims 5-7 to improve the multiple dependent claim wording. No new matter has been added.

The Examiner also rejected claim 1 under 35 USC 102(b) as being anticipated by an 1876 reference, Pond U.S. Patent No. 183,205. Applicants respectfully traverse this rejection. Contrary to the Examiner's assertion regarding claim 1, Pond does not disclose all the features of the claimed invention. First, Pond's sensor unit is not movable with respect to its holder, rather it is integral with it. In contrast, the claimed sensor unit is movable with respect to the fixing stand because it can be slid to such a position as to close the opening 24 of the base 22. See paragraph [0050]. Additionally, while the claimed sensor unit comprises at least one pressure sensitive part and a pressure part for pressing the at least one pressure sensitive part against the living organism, Pond's sensor unit only contains the pressure sensitive part. Pond's pressure

parts for pressing the pressure sensitive part are his screws, N, which are used to join parts L and M of the holder. Likewise, Pond does not disclose a fastening band as in the claimed invention. His parts L and M are two parts of a frame that are joined by screws. This is not the same as a fastening band. Thus, claim 1 is patentable over the cited reference.

The Examiner rejected claim 1 under 35 USC 102(e), and similarly rejected claims 2-5 under 102(a) and claims 6 and 7 under 35 USC 103(a) as being unpatentable over Sato U.S. Patent Publication No. 2004/0193061. These rejections are respectfully traversed. Sato is not prior art to this application. Attached herewith is a certified English language translation of applicants' Japanese priority application. Thus, claims 1, 2-5, 6 and 7 are patentable over the cited reference.

The Examiner rejected claim 1 under 35 USC 102(e) as being anticipated by Hashimoto U.S. Patent Publication No. 2004/0010199. Applicants respectfully traverse this rejection. Hashimoto does not disclose a pressure part control unit for controlling the pressure part, characterized in that the pressure part control unit is contained on the fixing stand. Rather, Hashimoto discloses a pressure part control unit in Sensor Unit 1. As can be seen in Fig. 1 of Hashimoto, Sensor Unit 1 with the pressure control unit is not contained on a fixing stand. Thus, claim 1 is patentable over the cited reference.

The Examiner rejected claims 1-7 under 35 USC 103(a) as being unpatentable over Yamasawa U.S. Patent No. 4,844,084 in view of two other references. Applicants respectfully traverse this rejection. The rejection is untenable because the combination constructed by the Examiner is not the claimed invention. Thus, the invention could not have been obvious, even in hindsight.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim

limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claim 1, as amended, recites a fixing stand for fixing a living organism in position; a sensor unit movable with respect to the fixing stand and adapted to be positioned on the living organism when the living organism is positioned on the fixing stand, the sensor unit comprising at least one pressure sensitive part and a pressure part for pressing the at least one pressure sensitive part against the living organism positioned on the fixing stand; a fastening band connecting the fixing stand and the sensor unit for fixing the living organism between the fixing stand and the sensor unit; and a pressure part control unit for controlling the pressure part, characterized in that the pressure part control unit is contained on the fixing stand.

First, Yamasawa does not disclose the claimed fixing stand for fixing a living organism in position and sensor unit movable with respect to the fixing stand and adapted to be positioned on the living organism when the living organism is positioned on the fixing stand. In Yamasawa, there is no need to position the living organism on what the Examiner calls the fixing stand, which is simply a casing on which the finger cuff is attached. Here, Yamasawa's finger cuff does all the living organism fixing and fastening, and this is not the claimed invention. Additionally, the Examiner cannot make the finger cuff part of the fixing stand, since the cuff contains the sensor unit, which in the claimed invention is "movable with respect to the fixing stand": an object cannot be movable with respect to itself.

Similarly, Yamasawa does not disclose a fastening band connecting the fixing stand and the sensor unit for fixing the living organism between the fixing stand and the sensor unit as in the claimed invention.

The Examiner admits that the Yamasawa does not disclose the use of pressure-sensitive parts for measuring pulse waves as part of the sensor unit. The Examiner attempts to supply the missing piece turning to Hon U.S. Patent No. 5,025,792. Hon discloses a pressure measuring transducer in the form of a strain gauge. This, too, is not the claimed invention. In the claimed

invention, the sensor unit comprises at least one pressure sensitive part and a pressure part for pressing the at least one pressure sensitive part against the living organism positioned on the fixing stand. Combining Yamasawa's finger blood pressure monitor and Hon's s strain gauge to produce the invention requires impermissible hindsight.

Even if the resulting combination suggested by the Examiner included all the limitations of claim 1, the cited references provide no evidence of a motivation to combine their disclosures so as to arrive at the claimed invention. The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination. Yamasawa is directed to a system for measuring blood pressure using a finger cuff. Hon is directed to a blood pressure measuring apparatus that senses pressure using a strain gauge on a portion of cutaneous tissue that has been isolated. The Examiner has pointed to no disclosure in Hon, the alleged evidence of such a motivation, which would have motivated a person of ordinary skill in the art to use Yamasawa's finger cuff method with Hon's strain gauge measuring device. Applicants' invention may be a straightforward and elegant solution to the problem it addresses, but the cited prior art is devoid of a suggestion to make it. Accordingly, the invention claimed is patentable over the prior art, and claims 1-7 should be allowed.

The Examiner rejected claims 6 and 7 under 35 USC 103(a) as being unpatentable over Yamasawa, Hon and Kondo U.S. Patent Publication No. 2002/0151775. Since claims 6 and 7 depend indirectly from claim 1, the logic above also disposes of this rejection. Additionally, Kondo is a watch-type biometric measuring device that particularly relates to an improved wristband. Again, the Examiner has pointed to no disclosure in Kondo, the alleged evidence of a motivation to locate a display unit and operating sensor on the sensor unit of the apparatus or locate the arithmetic processing unit, display unit and operating unit on the sensor unit of the apparatus, which would have motivated a person of ordinary skill in the art to combine Yamasawa, Hon and Kondo. Thus, claims 6 and 7 are patentable over the cited references.

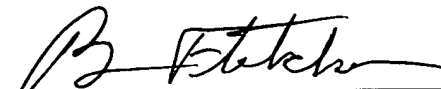
In view of the above, each of the claims in this application is in condition for allowance. Accordingly, applicants solicit early action in the form of a Notice of Allowance.

In the event that the transmittal letter is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing Docket No. **163852020600**.

Respectfully submitted,

Dated: July 14, 2006

By:



Brian N. Fletcher
Registration No. 51,683

Morrison & Foerster ^{LLP}
1650 Tysons Boulevard, Suite 300
McLean, Virginia 22102
Telephone: (703) 760-7796
Facsimile: (703) 760-7777